

JUL 25 2006

**REMARKS**

Claims 1-25, all the claims pending in the application, stand rejected under 35 U.S.C. §101. Claims 1-24 stand rejected on prior art grounds. Claims 1-3, 8-9, 11-13, 16-18, and 20-25 are amended herein. Applicants respectfully traverse these rejections based on the following discussion.

**I. The 35 U.S.C. §101 Rejection**

Claims 1-25 stand rejected under 35 U.S.C. §101 because the Office Action suggests that the claimed invention is directed to non-statutory subject matter having no tangible result. These rejections are traversed as explained below. The amended claims clearly provide a tangible result; i.e., "presenting the reordered ordered set with said related pages placed first to a user" (claim 1); "presenting the ranked related pages to a user" (claims 17 and 21). Moreover, the Applicants strongly suggest that claim 20 originally provided a tangible result; i.e., "an output interface to output said reordered results set". MPEP §2106 states that:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Here, the Office Action fails to establish a *prima facie* case that the claimed invention as a whole does not produce a useful result. Clearly, the Applicants' claimed invention is directed

to presenting to a user a reordered web search listing that allows a user to better isolate relevant web pages relating to his/her query search. Such a practical application of the claimed invention is clearly provided in the Applicants' specification as originally filed, and for anyone who has ever conducted a search on the Internet for web pages related to a given query, the claimed invention indeed offers a useful and tangible result to allow for a better and more efficient search process. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

## **II. The Prior Art Rejections**

Claims 1, 8-9, 11, 17-18, 20-22, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks (U.S. Patent No. 6,338,057), in view of Kobayashi, et al. (U.S. Patent No. 6,654,742), hereinafter referred to as Kobayashi. Claims 2-7, 10, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks, in view of Kobayashi, in further view of Official Notice. Claims 12 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks, in view of Kobayashi, in further view of Jacobson, et al. (U.S. Patent No. 6,167,397), hereinafter referred to as Jacobson. Claims 13-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Weeks, in view of Kobayashi, in further view of Jacobson, and in further view of Official Notice. Applicants respectfully traverse these rejections based on the following discussion.

The claimed invention, as provided in amended independent claims 1, 17, 20, and 21 contain features, which are patentably distinguishable from the prior art references of record. Specifically, amended independent claim 1 provides, in part, "...using a search engine returning

an ordered results set for a search statement; identifying a presence of a point query in said search statement; if said point query is present, accepting said ordered results set; identifying a presence of a recurring search event in said results set, wherein said recurring search event consists of information in said ordered results set relating to any of a same entity and occurs at different intervals of time, and different versions of information relating to said same entity; if a recurring search event is present, then identifying a pattern from said results set, wherein identifying a pattern includes setting an attribute and searching for said attribute near to an occurrence of at least a part of said search statement in web pages of said results set; identifying related pages within the results set containing said pattern; ranking said related pages; reordering said ordered set to place said related pages first; and presenting the reordered ordered set with said related pages placed first to a user. Amended independent claims 17 and 21 provide, in part, "...identifying a presence of a point query in a search statement, wherein said point query is identified by a presence of keywords; identifying a presence of a recurring search event in a results set for said search statement, wherein said recurring search event consists of information in said ordered results set relating to any of a same entity and occurs at different intervals of time, and different versions of information relating to said same entity, and wherein said recurring search event occurs when keywords appear in said results set are within 10-15 words before or after occurrences of said search statement; identifying a pattern from said results set, wherein identifying a pattern includes setting an attribute and searching for said attribute near to an occurrence of at least a part of said search statement in web pages of said results set; identifying related pages within the results set containing said pattern; ranking said related pages; and presenting the ranked related pages to a user." Moreover, amended independent claim 20

provides, in part, "...an input interface operable for receiving a user specified search statement; a processor operable for implementing a search engine to return an ordered set of search results for said search statement, identifying a presence of a point query in said search statement; if said point query is present, accepting said ordered results set; identifying a presence of a recurring search event in said results set, wherein said recurring search event consists of information in said ordered results set relating to any of a same entity and occurs at different intervals of time, and different versions of information relating to said same entity; if a recurring search event is present, then identifying a pattern from said results set, wherein identifying a pattern includes setting an attribute and searching for said attribute near to an occurrence of at least a part of said search statement in web pages of said results set; identifying related pages within the results set containing said pattern; ranking said related pages; and reordering said ordered set to place said related pages first; and an output interface to output said reordered results set." All of these features are neither taught nor suggested in the prior art of record.

Such features would be unobvious with the combined teachings of Weeks, Kobayashi, Jacobson, and Official Notice. In fact, the Applicants respectfully make a demand of evidence that supports the position in the Office Action that it is well-known to identify equal incremental changes in the attribute in different web pages (as it relates to claim 13). The Office Action (page 7) indicates that such a limitation is in fact well-known and takes Official Notice to support the position. However, the Applicants challenge this assessment because Weeks, Kobayashi, and Jacobson do not provide for this teaching, and in fact, provide for determining changes in the attribute in different web pages based solely on an arithmetic/weighted difference between the attribute in different web pages. Accordingly, using an equal incremental change

would not be considered well-known in the art to one of ordinary skill in the art.

Insofar as references may be combined to teach a particular invention, and the proposed combinations of Weeks, Kobayashi, Jacobson, and Official Notice, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined. There is nothing in each of the references that suggests the motivation to combine as suggested in the Office Action. In fact, had such a motivation been anticipated in any of the prior art references, then surely some discussion regarding alternative embodiments or manners of combination would have been suggested or at least inferred in any of the prior art references. In fact, no suggestion for combination is provided in any of the prior art references.

In In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroval, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination." There is nothing in the prior art that refers to a suggestion or desirability of making the proposed combination. Accordingly, the rejection under 35 U.S.C. §103(a) is prima facie defective.

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for

a part of another reference in order to try to meet, but failing nonetheless, the Applicants' novel claimed invention. Moreover, there is nothing in the prior art references themselves, namely Weeks, Kobayashi, Jacobson, and Official Notice, which suggests a motivation to combine elements from each reference in a manner consistent with the suggestion by the Office Action. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as "wherein said recurring search event consists of information in said ordered results set relating to any of a same entity and occurs at different intervals of time, and different versions of information relating to said same entity, and wherein said recurring search event occurs when keywords appear in said results set are within 10-15 words before or after occurrences of said search statement; identifying a pattern from said results set." As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Weeks fail to disclose all of the elements of the claims of the Applicants' invention, particularly, the conflict-free policies, as discussed above, but also, if combined with Kobayashi, Jacobson, and Official Notice in various combinations thereof, fails to disclose these elements as well. The unique elements of the claimed invention

are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Weeks, alone, or in combination with Kobayashi, Jacobson, and Official Notice teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness." In view of the foregoing, the Applicants respectfully submit that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 17, 20, and 21 and as such, claims 1, 17, 20, and 21 are patentable over Weeks, alone, or in combination with Kobayashi, Jacobson, and Official Notice. Further, dependent claims 2-16, 18-19, and 22-25 are similarly patentable over Weeks, alone, or in combination with Kobayashi, Jacobson, and Official Notice, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicants respectfully request that these rejections be reconsidered and withdrawn. Moreover, the Applicants note that all claims are properly

supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

### III. Formal Matters and Conclusion

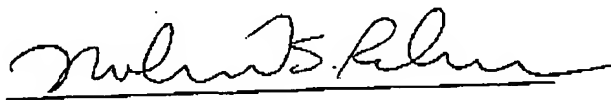
With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-25, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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